REMARKS

No claims have been amended, canceled, or added. As a result, claims 1-68 are pending in this application.

Information Disclosure Statements

In response to the Incomplete Information Disclosure Statements, attached herewith are the four initialed copies of Forms PTO-1449 previously submitted by Applicants and initialed as having been considered by Examiner John L. Young on May 3, 2004. Please have the Forms PTO-1449 made of record.

Additionally, Applicants submitted an Information Disclosure Statement and a 1449 Form on April 1, 2004. A copy of that Form PTO 1449 is enclosed with this Response. Applicants note that on two of the initialed Forms PTO 1449, under Other Documents, a reference was not initialed.   Applicants respectfully request that an initialed copy of the 1449 Forms be returned to Applicants' Representatives to indicate that the cited references have been considered by the Examiner and made of record.

§112 Rejection of the Claims

Claims 2, 25, 43 and 60-68 were rejected under 35 U.S.C. § 112, first paragraph, as lacking adequate description or enablement. Applicants respectfully traverse this rejection.

For claims 2, 25, 43, 65, and 66, the Action rejected "known behavior of individual users" as not being enabled by the specification, because "i.e., there is no disclosure as to how said behavior is known." Applicants respectfully disagree. Enablement of claims 2, 25, 43, 65, and 66 is at least found at paragraphs 43 and 29 of the current application publication US2002/0128904A1.

On page 4, in paragraph 43, the current application publication states:

> "One random factor, e.g., is that the system does not know whether a given user
> will log on at any given time period. Another random factor is that the amount of
> time the subscriber will be logged on (i.e., the length of an online session) is
> unknown. Accordingly, the number of advertisements that can be delivered to a
> particular subscriber for some given time period is unknown. *The system models
> these random factors and uses probability distributions, expected values and*

related statistical computations based on knowledge of prior observed online behavior of users." (Emphasis added).

Further, on page 3, in paragraph 29, the current application publication states:

"[0029] The Capacity Forecaster 52 determines campaign achievability by examining the number of qualified subscribers who match the campaign's profile using the Matcher and then calculating the current load (or alternatively, the available capacity, i.e., surplus) on those users due to previously scheduled campaigns. More particularly, the Capacity Forecaster 52 calculates the current load (or surplus) based upon statistics of how many impressions a subscriber can support compared to how many advertisements the subscriber is already scheduled to receive due to existing campaigns. *(The statistics include data previously gathered on subscribers such as, e.g., how frequently a given subscriber logs on and the lengths of his or her sessions.)* The total load on each subscriber is calculated by summing the loads contributed by each campaign. If a sufficient number of available subscribers is not available or if the load on the subscribers is too high, the Capacity Forecaster 52 identifies and suggests constraints to relax so that the campaign goals can be met such as, e.g., increasing the campaign length, reducing the number of requested impressions, or relaxing the profile constraints." (Emphasis Added).

For claims 60-68, the Action rejected "determining an expected number of deliveries of said items of content based on the expected position" as not being enabled by the specification. Applicants respectfully disagree and refer the Examiner to relevant paragraphs of the current application publication US2002/0128904A1. Enablement of claims 60-68 is at least found at paragraphs 59, 55 and 48 of the current application publication.

The current application publication recites, at page 5, paragraph 59:

"[0059] Also we call P.sub.j the population of subscribers who are eligible for ad type j and we recall that p is the fraction that log on during a random day. Thus the product Pp is the expected number of subscribers who log on during a random day and who are eligible for ad type j. F(x) is the probability that a logged on subscriber will have a session time less than or equal to x minutes in length. This means that F(.DELTA.E[Q.sub.j]) is the probability that a logged on subscriber will have a session time less than or equal to .DELTA.E[Q.sub.j] minutes. Consequently, {1-F(.DELTA.E[Q.sub.j])} is the probability that a logged on subscriber will have a session time greater than to .DELTA.E[Q.sub.j] minutes. *Thus, recognizing the LHS (left hand side) as the expected number of successful ad j placements during a day, we can write... [Equation containing E[Q.sub.jd]]."* (Emphasis Added).

Where E[Q.sub.jd] is defined at page 4, paragraph 55 of the current application publication as follows:

"[0055] *Suppose E[Q.sub.jd]="average Queue placement for ad type j on day d"* is thought of as an engineering approximation to its distribution over Queue placements. For instance, if E[Q.sub.jd]=11.4, then ad type j averages between the 11.sup.th and 12.sup.th place in all individual ordered lists that include ad type j. Sometimes ad type j may find itself in a front position in an individual ordered list, perhaps even first or second; sometimes it may trail far back in the pack, perhaps at position 30 or so. The number 11.4 represents an average position over all individual ordered lists that are generated and that include ad type j." (Emphasis Added).

Further, on page 4, in paragraphs 48, the current application publication states:

"[0048] Equation (1) indicates that the probability that the k.sup.th advertisement slated for delivery will be successfully placed is equal to the product of two quantities: the probability p that the subscriber logs onto the Web on a given day and the conditional probability (given that he or she has logged on) that he or she remains logged on for at least kT minutes. Since F.sub.s(s) is a monotone non-decreasing function of s, p.sub.k is a non-increasing function of k. *In other words, the likelihood of successfully placing an advertisement becomes less and less as the advertisement is placed lower in the advertisement priority list of the master plan generated by the Inventory Manager 51.*" (Emphasis Added).

For the above reasons, Applicants respectfully request that the §112 rejection be withdrawn.

§*103 Rejection of the Claims*

Claims 1-13 and 15-59 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Dimitriadis et al. (U.S. 5,664,949) in view of Marsh et al. (U.S. 5,848,397). This rejection is respectfully traversed.

The Office Action has the burden under 35 U.S.C. §103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To establish a *prima facie* case of obviousness under 35 U.S.C. §103, the prior art reference (or references when combined) must teach or suggest every claim element. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA, 1974). MPEP §2143.

Applicants respectfully submit that the Office Action did not make out a *prima facie* case of obviousness, because it is not clear that the combined references, and in particular Marsh,

teach each and every claim element of independent claims 1, 24, 38, 39, 42, and 56. In particular, it is respectfully submitted that it is not clear that Marsh, including the weighted scheduling criteria of Marsh, at col. 4, lines 7-15, col. 10, lines 29-38, and col. 13, lines 8-18 recites: "an ordered list... based on the expected values" as recited in claims 1, 38, 42, and 56, nor that Marsh recites: "generating an individual list of advertisements... based on user profile data..." as recited in claim 24, nor that Marsh recites: "generating an ordered master list of items... based on the probability data" as recited in claim 39.

In fact, the weighting constants c_1, c_2, c_3, and c_4 of Marsh, referred to in the Action, are "...time to expiration (tte), time since last seen (tsls), maximum exposures (me) and percent remaining exposures (pre)." Marsh, column 9, lines 44-49. These weighting constants appear to be directed towards data concerning the individual advertisements, rather than data concerning the user. The Action has simply failed to demonstrate that these weighting constants are equivalent to the 'expected values' (e.g., "relating to each user being online"), the 'user profile data,' and the 'probability data' recited in the independent claims 1, 24, 38, 39, 42, and 56.

Neither Dimitriadis nor Marsh teaches each and every claim element of independent claims 1, 24, 38, 39, 42, and 56. Therefore, the Office Action failed to establish a *prima facie* case of obviousness. Claims 1, 24, 38, 39, 42, and 56 are therefore patentable over the cited references.

Further, it is respectfully submitted that it is not clear that col. 15, lines 60-61 of recites: "determining expected values relating to each user being online during a given time period" as recited in at least claim 1.

In fact, col. 15, lines 58-61 of Marsh recites:

"...the usage profile of the user (e.g., statistical information collected in the statistics log file at the user's computer 101) to ascertain expected *advertisement consumption* over a predetermined period." (Emphasis Added).

Applicants disagree with paragraphs 8-10 of the current Action that "viewing advertising" of Marsh may be considered "being online" as recited in claim 1. For example, Marsh at col. 6, lines 66 to col. 7, line 1 recites: "The primary vehicle for presenting information, such as advertisements, to users during periods of *off-line* activity is the banner advertisement." (Emphasis Added).

For this additional reason, neither Dimitriadis nor Marsh teaches each and every claim element of independent claim 1. Therefore, the Office Action failed to establish a *prima facie* case of obviousness. Claim 1 is therefore patentable over the cited references.

Further, it is respectfully submitted that it is not clear from the Action that Marsh recites: *"a central computer for determining data relating to a probability of a given user being online during a given time period...*and a plurality of local computers linked to said central computer, each local computer generating an individual schedule for each of a set of users logging on to said computer on user login"* as recited in independent claim 39 (Emphasis Added).

For this additional reason, neither Dimitriadis nor Marsh teaches each and every claim element of independent claim 39. Therefore, the Office Action failed to establish a *prima facie* case of obviousness. Claim 39 is therefore patentable over the cited references.

For the above reasons, Applicants respectfully request that this rejection be withdrawn.

Claims 2-13, 15-23, 25-37, 40-41, 43-55, 57-59 depend, directly or indirectly, on one of claims 1, 24, 38, 39, 42, or 56, and are patentably distinguishable over the references respectively cited against them in the Office Action, for the reasons argued above. These dependent claims are also patentable in view of the additional elements that they provide to the patentable combination.

Claims 60-68 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Marsh et al. This rejection is respectfully traversed.

Applicants respectfully submit that the Office Action did not make out a *prima facie* case of obviousness, because it is not clear that the combined references, and in particular Marsh, teach each and every claim element of independent claim 60. In particular, it is respectfully submitted (and discussed above) that it is not clear that Marsh, at col. 4, lines 7-15, col. 10, lines 29-38, and col. 13, lines 8-18, and col. 15, lines 60-61, recites:

> "determining an expected position of the item of content in the series based on the number of online users having the specified characteristics, a probability that a random user having the specified characteristics will be online during the specified time period, a predicted session length for the random user, and the time period between deliveries of said items of content" as recited in independent claim 60.

Marsh simply does not teach each and every claim element of independent claim 60.

Therefore, the Office Action failed to establish a *prima facie* case of obviousness. Claim 60 is

therefore patentable over the cited reference. Applicants respectfully request that the rejection be

withdrawn.

Claims 61-68 depend, directly or indirectly, on claim 60, and are patentably

distinguishable over the references respectively cited against them in the Office Action, for the

reasons argued above. These dependent claims are also patentable in view of the additional

elements that they provide to the patentable combination.

Allowable Subject Matter

Claim 14 was objected to as being dependent upon a rejected base claim, but was

indicated to be allowable if rewritten in independent form including all of the limitations of the

base claim and any intervening claims.

Claim 14 depends from claim 8, and claim 8 depends from claim 1. Because claims 1

and 8 are in condition for allowance, as discussed above; claim 14 is also allowable as originally

submitted since it is dependant upon claims which are believed to be allowable. Applicants

respectfully submit that claim 14 is in condition for allowance.
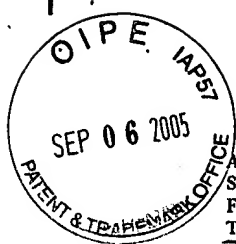
AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111
Serial Number: 09/767,793
Filing Date: January 23, 2001
Title: METHOD AND SYSTEM FOR SCHEDULING ONLINE TARGETED CONTENT DELIVERY

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Dkt: 2050.004US1

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at 408-278-4042 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

TIM CARRUTHERS ET AL.

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Date ___Sept. 1, 2005___

By _____
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this __1__ day of September, 2005.

___KATE GARRISON___   ___Kate G___

Name   Signature